

REMARKS

Claims 1 and 3-14 are pending in the present application. Claims 8 and 9 are withdrawn from consideration. Claims 1-7 and 10-14 are rejected. Claim 2 is herein canceled. Claims 1, 11 and 14 are herein amended. No new matter has been presented.

Claim Rejections - 35 U.S.C. §112, second paragraph

Claims 11 and 14 are rejected under 35 U.S.C. §112, second paragraph as being indefinite. The Examiner asserts that in claim 11, in view of the carbon atom range of 5 to 22 within claim 1, it cannot be determined how to interpret or reconcile the 1 to 20 carbon atom range of the dependent claim.

Applicants herein amend claim 11 to recite that "...Rf represents a perfluoroalkylene group having 1 to 20 3 to 20 carbon atoms...". There is therefore clearly no contradiction in the different carbon numbers.

Applicants note that in claim 11, the fluorine-containing aliphatic diisocyanates (A11) is defined as a diisocyanate represented by OCN-CH₂-Rf-CH₂-NCO by the present amendment. With this modification, in claim 11, the number of carbon atoms in the perfluoroalkylene group (Rf) is also defined as 3 to 20. The support for the amendment of claim 11 is as follows.

Paragraph [0012] of the specification describes that, "As the fluorine-containing nonaromatic polyisocyanate (A1), fluorine-containing aliphatic diisocyanates (A11) having 5 to 22 carbon atoms (this number does not take account of carbon atom(s) in an isocyanate group, hereinafter the same shall apply) can be used." As described above, the fluorine-containing

aliphatic diisocyanates (A11) is a diisocyanate represented by OCN-CH₂-Rf-CH₂-NCO. Here, Rf represents a perfluoroalkylene group having 1 to 20 carbon atoms (paragraph [0013]), therefore, the lower limit of the number of carbon atoms in the fluorine-containing aliphatic diisocyanates (A11) should be "3", but not "5" (because carbon atom(s) in an isocyanate group are not taken into account). On the other hand, the upper limit of the number of carbon atoms is 22.

The Examiner asserts that the use of "may" renders the claim indefinite, because it is unclear if or to what extent the language denoted by "may" is optional. Applicants herein amend the claim to recite that the perfluoroalkylene group "~~may contain~~ optionally contains" an ether bond. Applicants note that the MPEP §2175.05(h)(III) indicates that the term "optionally" is acceptable where, as herein, there is no ambiguity as to which alternatives are covered by the claim.

With respect to claim 14, the Examiner asserts that the term "type" renders the claim indefinite. Applicants herein amend the claim to remove the term "type".

Claim Rejections - 35 U.S.C. §103(a)

Claims 1-7 and 10-14 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 03/051952 in view of Hiraishi et al. ('266) or Nakamura et al. (U.S. 2003/0225239) or Sparer et al. (U.S. 2004/0033251) or Felt et al. (U.S. 2005/0060022).

The Examiner considers Applicants' examples within the specification and the examples within Applicants' 37 C.F.R. §1.132 declaration filed December 26, 2007 as insufficient to rebut the *prima facie* case of obviousness.

The Examiner notes that Applicants' examples are limited to specific polyisocyanates, specific polyol compounds having specific characteristics, and specific phenolic radical scavengers used in specific amounts. On the other hand, Applicants' claims are not so limited. The Examiner further notes pages 9-11 of the response of February 26, 2009, in which Applicants provide arguments why one would expect components not exemplified but encompassed by the claims to yield results comparable to the results set forth within the examples. The Examiner asserts that Applicants' arguments amount to little more than unsubstantiated opinion; Applicants have not presented any factual evidence that supports their position for the full scope of components encompassed by the claims.

Claim 1 is herein amended to include the limitations of claim 4 and to specifically define a content of oxyethylene groups in the polyol component (B), the hydrophilic polyol (Bi) and the phenolic radical scavenger (PRS). Supports for the amendments can be found in paragraphs [0012], [0013], [0050 [0078], [0098] and [0123] of U.S. publication of the present application.

The Examiner indicates that the showings are not commensurate in scope with the claims in section 7 of the Office Action. Applicants respectfully disagree, however, Applicants add additional experimental data to ensure commensuration between the claims and the description.

Applicants submit herewith declaratory evidence by one skilled in the art as to why one would have expected components not exemplified but encompassed by the claims to yield results

comparable to the results set forth within the examples, in contrast with evidence dismissed as mere Attorney argument in the body of a response.

In the present invention, only shown are experimental data of the medical adhesive using a diisocyanate represented by OCN-CH₂-Rf-CH₂-NCO (hereinafter referred as “a”), but not shown about a diisocyanate represented by OCN-Rf-NCO (hereinafter referred to as “b”) as “a fluorine-containing aliphatic diisocyanate (A11) having 3 to 22 carbon atoms”.

However, as noted in the previous response, the Applicant submits that the claimed invention is disclosed as discussed below even though not showing b.

With respect to the hydrophilic polyol, claim 1 is amended to recite, “...a content of oxyethylene groups in the polyol component (B) is 30 to 100% by weight based on the weight of oxyalkylene groups in (B),

the hydrophilic polyol (B1) is at least one of a polyether polyol (B1-1) and a polyester polyol (B1-2),

an equivalent weight of the hydroxyl group in the hydrophilic polyol (B1) is from 50 to 5,000.”

Experimental data about the medical adhesive using a polyether polyol (B1-1) have been shown so far. Applicants submit herewith experimental data about the medical adhesive using a polyester polyol (B1-2) as “a hydrophilic polyol (B1)” this time.

With respect to the phenolic radical scavenger, claim 1 is amended to recite, “the phenolic radical scavenger (PRS) is at least one selected from the group consisting of a mono-

phenolic radical scavenger, a bisphenolic radical scavenger and a polymer phenolic radical scavenger.”

In Examples of the description, examples using a polymeric phenolic radical scavenger are disclosed. In the previous response, data about a monophenolic radical scavenger and a bisphenolic radical scavenger have been shown with the Declaration file therewith.

In addition to these data, concerning data about the polyester polyol (B1-2) to be submitted this time, Applicants show data using a monophenolic radical scavenger, a bisphenolic radical scavenger, and a polymer phenolic radical scavenger as the phenolic radical scavenger (PRS).

Accordingly, the Applicant believes that the aggregate of the claimed invention is disclosed with the present and previous examples. Consequently, Applicants submit that the claimed invention is also disclosed from the viewpoint of the phenolic radical scavenger.

As discussed above in detail, the claimed subject matter is disclosed sufficiently, and the showings are commensurate in scope with the claims. Therefore, unexpected results of the present invention should be acknowledged over the cited documents.

Accordingly, the obviousness rejection has been rebutted.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

Application No. 10/594,627
Attorney Docket No. 063012

Amendment under 37 C.F.R. §1.111
Amendment filed June 26, 2009

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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KHS/adp
Enclosure: Declaration under 37 C.F.R. §1.132